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OFFICE OF PETITIONS

In re Application of :
Michael Shetley :
Application No. 10/620,967 : ON PETITION
Filed: June 14, 2003 :
Attorney Docket No. 2552.005 :

This is a decision on the petition under 37 CFR 1.182 filed January 22, 2004.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is not a final agency decision.

Petitioner has requested that the Patent and Trademark Office establish Emission Controls Corp. ("ECC") as the owner and assignee of the above-cited patent application and underlying invention although ECC has not been able to get inventor Shetley to execute an assignment transferring his ownership rights in the invention and patent application to ECC. The petition cannot be granted because the Office does not make determinations of ownership of patent property.¹ Rather, the Office only acts in a ministerial role by recording the assignment documents in the Office assignment records, or making the assignment document of record in the file of a patent application, patent, or other patent proceeding. To that end, Section 301 of the *Manual of Patent Examining Procedure* (MPEP) provides, in pertinent part, that:

... [a]n assignment can be made of record in the assignment records of the Office. Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property.

Further, Section 317.03 of the MPEP provides, in pertinent part, that:

The recording of a document is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent. When necessary, the Office will determine what effect a document [assignment document] has, including whether a party has the authority to take an action in a matter pending before the Office.

¹ The Office may, in limited circumstances, make a determination of ownership when two conflicting statements under 37 CFR 3.73(b) have been filed. In these cases, unlike in instant situation, the ownership or chain of title has already been established and detailed in the statement under 37 CFR 3.73(b). See MPEP § 324.

The Office cannot establish ECC as the assignee; ECC must establish its ownership rights for itself and present conclusive evidence of such ownership, e.g., a executed assignment document, to the Office for recordation. If, as in this case, there is an apparent dispute as to who should own the invention at issue and who should have the right to act in the underlying patent application, the matter will likely have to be determined by the appropriate court as the sole inventor has executed the declaration under 37 CFR 1.63 thereby signifying his intent to join the prosecution of the application. Without some conclusive determination of ownership rights to which all relevant parties have agreed or as determined by another appropriate body, the Office does not have the authority to exclude the inventor from the application's prosecution or proclaim that ECC has an exclusive right to the patent property.

The address as cited on the instant petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address as cited on the petition, petitioner is advised that all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

Further correspondence with respect to this matter should be addressed as follows:


By mail: Mail Stop Petitions
 Commissioner for Patents
 Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By Hand: Office of Petitions
 Crystal Plaza 4, 3C23
 2201 South Clark Place
 Arlington, VA 22202

The application will be sent to the Office of Initial Patent Examination for further processing.

Telephone inquiries should be directed to the undersigned at (703) 305-0010.



Kenya A. McLaughlin
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Office of Petitions

cc:
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President
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